REMARKS/ARGUMENTS

Claims 1-48 are pending. By this Amendment, claim 1 is amended. Claims 25-48 have been withdrawn from consideration pursuant to a restriction requirement.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

ELECTION/RESTRICTION:

The Examiner restricted the invention to either Group I, claims 1-24, drawn to a film, or Group II, claims 25-48, drawn to a method of making a film. Applicant made a provisional telephone election to prosecute Group I, claims 1-24. Applicant hereby affirms this election. This election is made without traverse. Applicant reserves the right under 35 U.S.C. § 121 to file a divisional application for the nonelected claims.

REJECTION UNDER 35 U.S.C. § 102:

The Examiner rejected claims 1-6, 8, 11-17 and 21-24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,824,394 (Kinoshita et al.). This rejection is traversed for the following reasons. First, based on claim 1 as amended, the base material of the film of the present invention must be predominantly polypropylene. The Examiner stated that Kinoshita et al. teaches, among other things, a laminate comprising a polyester film comprising a coating comprising urethane-based resin. Claim 1 of the present application is amended to include the limitation that the base film must be predominantly polypropylene.

Polypropylene films and polyester films are different from each other in several respects, and one of the most significant is polarity which drastically affects adhesion of coatings, inks, etc. Adhesion of water-based coatings of the type used in this invention is much stronger to surfaces of high polarity, *i.e.*, high surface energy. It is well known in the art that polyester films are more polar than polypropylene films due to the presence of oxygen-containing ester functionalities in the former. Indeed, wetting of polypropylene with polar materials is notoriously difficult since polypropylene consists essentially completely of hydrocarbon units which are hydrophobic or "water-hating". Polypropylene films routinely are oxidatively treated to increase polarity but, even after such treatment, they typically have lower surface energies than untreated polyester films (*e.g.*, 38 dynes/cm vs. 45 dynes/cm). Thus, it is by no means predictable that adhesion of the water-based coatings of this invention would adhere satisfactorily to polypropylene when applied after machine direction orientation stretching, but before transverse direction orientation stretching as has been shown to be the case.

Second, the Examiner stated that although Kinoshita teaches the same steps of stretching of the film, as claimed, it is the structural elements that impart patentability to an article and not how the layers are made. Applicant does not disagree, but asserts that an appropriate structural limitation is, in fact, properly included in claim 1 in that the urethane coating, as claimed, has substantially different structural characteristics when it has been applied to the polypropylene base film between a machine direction orientation and a transverse direction orientation. Kinoshita et al. do not teach or suggest these limitations.

Specifically, claim 1 includes the limitation of (a) a polymeric base film having a

predominant polymer of polypropylene, and (b) a urethane coating on said first side, said coating having been applied to said base film between a machine direction orientation and a transverse direction orientation of a two step tentering operation. Step (b) is not a process step. The urethane coating, having been applied in this manner, changes the physical properties of the film and causes the film to exhibit unique and patentable characteristics. Specifically, as stated in the present specification at, for example, page 5, lines 18 to 25, the coatings of the present invention provide a surface on oriented polypropylene that is receptive to a variety of inks and that demonstrate excellent water resistance. These characteristics are an improvement over prior polypropylene films. As stated in the present specification at page 1, lines 21-24,

> Films produced in a standard coating operation using the waterborne urethane dispersions without a topcoat result in a very tacky film that blocks on the machine winder and renders the roll unstable. The present invention is directed to a film where a low Tg coating is provided without the blocking tendency.

The Examiner's statement that structural elements impart patentability to an article is not disputed. Because the physical properties of improved ink adhesion, water resistance and other properties, the present invention, as claimed, must have structural differences that cause the different physical properties of the present invention.

An important distinction between the present application and the Kinoshita et al. patent is that Kinoshita et al. use polypropylene at very low levels as a voiding agent. Claim 1, as amended, includes the limitation that the base film must be a polymeric base film where the predominant polymer is polypropylene. The present amendment amends claim 1 to require that the polypropylene may not be a very small portion of the base film, as it is in Kinoshita et al.

Additionally, Kinoshita et al. do not teach the use of polypropylene to obtain the specific properties of the present invention. The base film of Kinoshita et al. is predominantly a polyester, as discussed throughout the Kinoshita et al. specification and claims. The present invention, as described in the specification and as included in the claims, specifically requires a base film that is predominantly polypropylene. See, for example, page 1, lines 11-17, page 3, lines 11-13, page 5, line 23 to page 6, line 3, page 6, lines 18-20, page 7, lines 4-8, page 8, line 12 to page 9, line 13 and page 8, lines 15-19.

Since Kinoshita et al. do not teach or suggest either the use of a base film having a predominant polymer of polypropylene and a urethane coating having been applied to the base polypropylene film between a machine direction orientation and a transverse direction orientation of a two step tentering operation, it is respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. § 102 and pass claims 1-6, 8, 11-17 and 21-24 to allowance.

REJECTION UNDER 35 U.S.C. § 103:

The Examiner next rejected claims 7, 9-10, 12 and 18-20 under 35 U.S.C. § 103(a) as being obvious over Kinoshita as applied to claims 1, 8 and 11. For the reasons set forth above with respect to the rejection under 35 U.S.C. § 102, since claim 1 is believed to be allowable and claims 7, 9-10, 12 and 18-20 depend either directly or indirectly from claim 1, it is asserted that these claims are also allowable. It is respectfully requested that the Examiner withdraw this rejection and pass claims 7, 9-10, 12 and 18-20 to allowance.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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Please charge or credit our Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.